

RECEIVED
CENTRAL FAX CENTER

AUG 26 2005

Atty Docket No. 017622-000130US

PTO FAX NO.: 571-273-0047

Examiner: Jan Hurley

Technology Center 3700

**OFFICIAL COMMUNICATION
FOR THE PERSONAL ATTENTION OF
MAILSTOP: Appeal Brief - Patents**

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following documents in re Application of TONY REID

Application No. 10/725,837, filed December 1, 2003

for MULTIPLE SLEEVE METHOD AND APPARATUS FOR TREATING EDEMA AND
OTHER SWELLING DISORDERS

is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Number of pages being transmitted, including this page: 12

Dated: 26 August 2005

Nancy Pizzo
Nancy Pizzo

Documents Attached

1. SB/21 - Transmittal Form
2. Appeal Brief (10 pgs)

RECEIVED
OIPE/IAP

AUG 29 2005

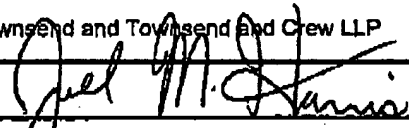
**PLEASE CONFIRM RECEIPT OF THIS PAPER BY
RETURN FACSIMILE AT (415) 576-0300**

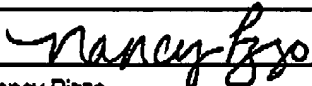
TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tele: 650-326-2400
Fax: 650-326-2422

0024 60571308 v1

PTO/SB/21 (09-04)

TRANSMITTAL FORM	Application Number	10/725,837	
	Filing Date	December 1, 2003	
	First Named Inventor	Reld, Tony	
	Art Unit	3784	
	Examiner Name	THANH, QUANG D	
(to be used for all correspondence after initial filing)		Attorney Docket Number	017822-000130US
Total Number of Pages in This Submission			

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavit(s)/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Appendices A-C
Remarks: The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Townsend and Townsend and Crew LLP	
Signature		
Printed name	Joel M. Harris	
Date	26 August 2005	Reg. No. 44,743

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted on the date stated below to the US Patent and Trademark Office at:		
Fax No. (571) 273-8300		
Signature		
Typed or printed name	Nancy Pizzo	Date 26 August 2005

60529514 v1

AUG 26 2005

I hereby certify that this correspondence is being Facsimile transmitted to the U.S. Patent and Trademark Office at the following Fax No.: 1-571-273-8300

on 26 August 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Nancy Pizzo
Nancy Pizzo

PATENT

Attorney Docket No.: 017622-000130US

Customer No. 20350

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Tony Reid

Application No.: 10/725,837

Filed: December 01, 2003

For: Multiple Sleeve Method And Apparatus
For Treating Edema And Other Swelling
Disorders

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner: Thanh, Quang D.

Art Unit: 3764

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

08/29/2005 HBIZUNES 00000010 201430 10725837
01 FC:1402 500.00 DA

Sir:

Further to the Notice of Appeal filed in the above-referenced patent application on July 1, 2005, Appellants appeal the final rejection of claims 1-10. Please deduct the requisite fee, pursuant to 37 C.F.R. § 41.20(b)(2), of \$500 from Deposit Account No. 20-1430, and deduct any additional fees or credit any excess fees associated with this Appeal Brief to such Deposit Account.

One copy of this Appeal Brief is hereby fax-filed pursuant to 37 C.F.R. § 41.37. **Appendix A**, attached hereto, contains a copy of all claims pending in this case. **Appendix B**, attached hereto, is marked the evidence appendix. **Appendix C**, attached hereto, is marked the related proceedings appendix.

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 2

REAL PARTY IN INTEREST:

The real party in interest of the present patent application is the inventor and owner thereof, Tony Reid.

RELATED APPEALS AND INTERFERENCES:

No other appeals or interferences are known by appellants which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS:

Claims 1-10 are pending in the application. Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,171,211 (Deasy) in view of USPN 814,795 (Myers). All pending claims are being appealed in the subject application. In accordance with 37 C.F.R. § 41.47(c)(1)(viii), the claims involved in the appeal are set forth in Appendix A (Pending Claims), attached hereto.

Note, that claims 1-10 have also been rejected under the judicially created doctrine against double patenting. Appellants had submitted a terminal disclaimer on Oct 25, 2004 to which the Examiner had objected. Appellants believe that this rejection has been mooted by entry of a Terminal Disclaimer which was faxed to the U.S. Patent and Trademark Office (USPTO) on August 24, 2005.

STATUS OF AMENDMENTS:

A Final Office Action was mailed from the USPTO on January 5, 2005. An Amendment under 37 C.F.R. § 1.116 was filed for this case on April 4, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER:

Embodiments of the invention provide systems, methods and apparatus to relieve swelling in limbs. Embodiments of the invention are particularly useful for applying pressure at selected locations on a patients limbs to reduce swelling due to lymphedema, edema and other swelling disorders such as venous insufficiency. (See the Specification, e.g., at page 4 lines 14-

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 3

22; and at page 7 lines 7-10). Independent Claim 1 is directed to a system for applying pressure to a body limb, comprising a first sleeve and a second sleeve. The first sleeve has a foam lining configured to be slid over the limb and to apply an inward pressure onto the limb. The second sleeve is configured to be slid over substantially the entire length of the first sleeve and to apply additional inward pressure along the length of the limb. At least the first sleeve can have a very low coefficient of friction and at least the second sleeve can consist essentially of thin fabric sleeves.

Independent Claim 5 is directed to a system for applying pressure to arm, comprising an innermost therapeutic pressure sleeve (TPS) and at least one second sleeve. The TPS has ridges formed over an inner surface and is configured to be slid over the entire length of the arm from the shoulder to the wrist and to apply an inward pressure thereon. The second sleeve configured to be slid over substantially the entire length of the TPS to apply additional inward pressure onto the limb. Support for claims 1 and 5 can be found in the specification, e.g., at pages 4-9, 12 and pages 16-17. Support for the ridges in claim 5 can be found e.g., at page 12 and Figures 3-5B.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

1) The rejection of claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Deasy in view of Myers.

ARGUMENT

A. The Examiner Has Not Established A *Prima Facie* Case Of Obviousness Of Claims 1-10 Over Deasy In View Of Myers.

In the Final Office Action of January 5, 2005, claims 1-10 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of the teachings of Deasy in view of Myers. As will be explained below, the rejection is in error because the Examiner fails to provide 1) a teaching or suggestion of all the limitations of the pending claims in the cited art, and; 2) a motivation for combining the references. Thus, the Examiner fails to establish a *prima facie* case of obviousness.

Deasy describes regions of an elastic suit intended for (among other things) treatment of edema where an upper sleeve partially overlaps with a lower sleeve. For example, referring to Figs 1, 4, and 5, it can be seen that the "coat-like portion 16" of the suit has sleeves 46 which

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 4

overlap at the elbows with the "tubular arm portions 18" of the suit. Similarly, referring to Figs 1, 2, and 3, the "leg segments 22" of the "pant-like portion 12" of the suit overlap with "tubular leg portions 14" at the knees. There is thus a region of the body suit where a first "sleeve" and a second "sleeve" overlap.

However, while Deasy describes an elastic body suit intended for treatment of edema, Deasy's suit has several deficiencies with respect to the claimed invention. In particular, the manner in which the sleeves overlap, however, is simply not as required by either of independent claims 1 or 5, the only independent claims in the present application. Independent claim 1 specifically requires that the second sleeve be configured "to be slid over substantially the entire length of the first sleeve and to apply additional inward pressure along the length of the limb."

In Deasy, regardless of which sleeve is considered first or the second, neither sleeve is adapted to be placed "over substantially the entire length of" the other sleeve in order to apply pressure "along the length of the limb." In the case of the arm sleeves, Deasy shows such overlap only at the elbow. In the case of the pant legs, such overlap is only in the region of the knee. See Deasy Col 4, lines 35-45. In particular, nowhere does Deasy teach a second sleeve that is configured to be slid over substantially the entire length of a first sleeve configured to be slid over the entire length of the arm from the wrist to near the shoulder.

Nor does Deasy recognize that it is desirable for inner and outer sleeves to combine the inward pressure they place on the limb. Instead, use of the separate arm and leg components seems to be a convenient way of allowing the user to put on and take off the suit, not in any way intended to enhance the treatment or increase pressure. Thus, Deasy fails to teach or suggest all the limitations of either independent claims 1 and 5. Further, as is discussed below, Myers does not compensate for this deficiency.

Even if one were to assume, for the sake of argument only, that Deasy taught the use of first and second sleeves generally as set forth in the present application, the Examiner's reliance on Myers to combine with a "foam lining" (claim 1) or "an innermost therapeutic pressure sleeve ... having ridges formed over an inner surface" (claim 5) is inappropriate. The elastic bandage of Myers is intended for a far different purpose and has a quite distinguishable structure from the claimed invention of either claim 1 or claim 5. The Myers bandage comprises a body 1 which is shaped to conform to the shape of the limb to provide an "outer surface smooth and free from irregularities." Lines 79 and 80. The purpose of the bandage is to "provide localized

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 5

compression" (Lines 63 and 64) or provide "special localized treatment" (Lines 57 and 58) of certain body parts. This is done by providing "outer encircling bands [for] which may either be integral or separately applied in order to give greater compression than the bandage alone at any desired point. See lines 42-46 of the specification. Indeed, the function of the Myers bandage is likened to a "tourniquet" (line 64), a purpose antithetical to that of the present invention and to that of Deasy as well (for example, Deasy teaches that its garment increases the user's stamina; clearly a tourniquet can not perform that function. See Deasy Col 4, lines 60-66). Thus, not only does Myers fail to compensate for the deficiencies of Deasy described above, but the combination actually teaches away from the present invention and impedes the stamina enhancing function of Deasy.

An obviousness rejection requires not only that the prior art teach each and every element set forth in the claims, but also that there be a showing of some motivation present in the references or in the general knowledge within the art to combine the reference teachings. In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (citing cases). The present rejection meets neither of these requirements. None of the cited references teach the requirement that first and second sleeves be configured so that a second sleeve slides "over substantially the entire length of the first sleeve and to apply additional inward pressure on the length of the limb." Moreover, while the Examiner has contended that it would be obvious to combine the teachings of Myers with those of Deasy (See 4/22/05 Advisory Action at page 2), the Examiner fails to point to any specific motivation for combining the references and indeed no such motivation exists. Thus, the rejection is deficient with respect to not one, but two requirements for a proper obviousness rejection.

An obviousness rejection is also improper when the combination of references teaches away from the claimed invention. See In re Gurley, 27 F.3d 551, 553, 31 (Fed. Cir. 1994). That is the case here since, as described above, the combination of Deasy and Myers does indeed teach away from the claimed invention.

Accordingly, for all the reasons above, Appellants submit that the Examiner has failed to establish a prima facie case of obviousness and therefore, respectfully request that the Board reverse the Examiner's rejection and allow claims 1-10.

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 6

B. The Rejection Under 35 U.S.C. § 103 Should Be Reversed As A Matter Of Law.

The courts have clearly established that the Examiner bears the initial burden of factually establishing and supporting a prima facie case of obviousness. In re Fine, 5 U.S.P.Q.2d at 1598, 1599; M.P.E.P. § 2142. See also In re Piasecki, 223 U.S.P.Q. at 787, 788. If the Examiner does not establish a prima facie case of obviousness, Appellants are under no obligation to submit evidence of nonobviousness, M.P.E.P. § 2142, See also In re Piasecki, 223 U.S.P.Q. at 787, 788, and a rejection on this ground should not be imposed, see, e.g., In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (stating that "if examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to the grant of a patent").

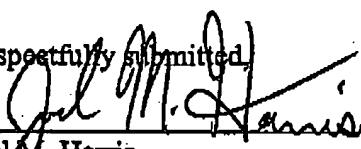
In the present case, for the reasons set forth above, the Examiner has not established a prima facie case of obviousness. In particular, the Examiner has not shown a teaching or suggestion of all the limitations of the pending claims in the cited art, nor has the Examiner pointed to any evidence, in the cited references or otherwise, showing a suggestion or motivation to modify the teachings of the cited references to achieve the invention as claimed. Accordingly, Appellants respectfully request that the Examiner's rejection should be reversed and the claims be allowed.

CONCLUSION

Appellants believe that the above discussion is fully responsive to all grounds of rejection set forth in the Final Office Action dated January 5, 2005.

If for any reason the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this Appeal, the Examiner is invited to telephone the undersigned at 650-462-5329.

Respectfully submitted,


Joel M. Harris
Reg. No. 44,743

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel (650) 326-2400 / Fax (415) 576-0300
60547082 v1

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 7

APPENDIX A

PENDING CLAIMS

1. A system for applying pressure to a body limb, said system comprising:
a first sleeve having a foam lining configured to be slid over the limb and to apply an inward pressure onto the limb; and
a second sleeve configured to be slid over substantially the entire length of the first sleeve and to apply additional inward pressure along the length of the limb.
2. A system as in claim 1, wherein at least the first sleeve has an outer surface with a low coefficient of friction.
3. A system as in claim 2, wherein at least the second sleeve consists essentially of thin fabric sleeves.
4. A system as in claim 3, wherein each of the sleeves independently provides an inward pressure in the range from 5 mmHg to 30mmHg.
5. A system for applying pressure to an arm, said system comprising:
an innermost therapeutic pressure sleeve (TPS) having ridges formed over an inner surface and configured to be slid over the entire length of the arm from the shoulder to the wrist and to apply an inward pressure thereon; and
at least a second sleeve configured to be slid over substantially the entire length of the TPS to apply additional inward pressure onto the limb.
6. A system as in claim 5, wherein the TPS has an outer surface with a low coefficient of friction.
7. A system as in claim 6, further comprising at least a third sleeve configured to be slid over the second sleeve to apply additional inward pressure onto the limb.
8. A system as in claim 7, wherein the second and third sleeves consist essentially of thin fabric sleeves.

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 8

9. A system as in claim 8, wherein each of the TPS and sleeves independently provide an inward pressure in the range from 5 mmHg to 30mmHg when placed over the arm.

10. A system as in claim 1, wherein the first sleeve is configured to cover an arm from the wrist to near the shoulder.

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 9

APPENDIX B

EVIDENCE

None.

U.S. Pat. Appl. No.: 10/215,357
Appeal Brief dated August 26, 2005
Page 10

APPENDIX C

RELATED PROCEEDINGS

None.